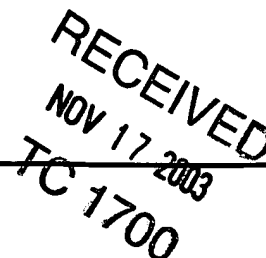


## TRANSMITTAL OF APPEAL BRIEF (Large Entity)

Docket No.  
TSL1469CIP

In Re Application Of: Shoji Akamatsu &amp; Mari Tateishi

Serial No.  
09/846,834Filing Date  
May 1, 2001Examiner  
La Toya I. CrossGroup Art Unit  
1743Invention:  LIQUID VIBRATION DAMPING COMPOSITIONTO THE COMMISSIONER FOR PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on

The fee for filing this Appeal Brief is: \$330.00

- ☐ A check in the amount of the fee is enclosed.
- ☒ The Director has already been authorized to charge fees in this application to a Deposit Account.
- ☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 04-1520

  
Signature

Dated: 11-10-03

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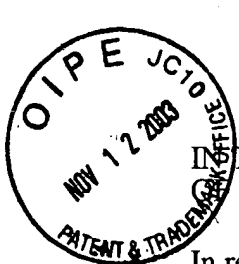
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I certify that this document and fee is being deposited on 11-10-2003 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

  
Signature of Person Mailing Correspondence

Kelly J. Smith

Typed or Printed Name of Person Mailing Correspondence



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD  
PATENT APPEALS AND INTERFERENCES

In re application of

Shoji Akamatsu & Mari Tateishi

Serial No. 09/846,834

Filed May 1, 2001

Title Viscous Liquid Vibration Damping Composition

Docket No. TSL 1469 CIP

) Appeal No.

) Group Art Unit 1743

) Examiner La Toya I. Cross

) November 7, 2003

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APPELLANTS' BRIEF UNDER 37 CFR 1.192(a)

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

Sir:

This is an appeal from the Final Rejection dated October 22, 2003, in which Claims 1-6 and 13 were finally rejected. Appellants' claims have been twice rejected, and so the appeal is proper under 35 USC 134.

REAL PARTY IN INTEREST

The real party in interest in this application is the assignee of record of the entire interest. The assignee of record of the entire interest is Dow Corning Toray Silicone Company, Ltd., Tokyo, Japan. The assignment was recorded on May 1, 2001, April 6, 1998, Reel 011781, Frame 0946.

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## RELATED APPEALS AND INTERFERENCES

Appellants, appellants' legal representative, or the assignee of record, do not know of any related appeal or interference in any other application, which would directly affect, or be directly affected by, or have any bearing on, the Board's decision in the pending appeal.

## STATUS OF CLAIMS

Claims 1-12 were originally filed in the application. In an amendment filed August 1, 2003, appellants canceled Claims 7-12 and added Claim 13. These claims are currently pending in the application and are the subject matter of this appeal.

## STATUS OF AMENDMENTS

No amendments have been filed subsequent to the final rejection under 37 CFR 1.116.

## SUMMARY OF THE INVENTION

This is a simple invention, and consists of a viscous liquid vibration damping composition containing a viscous liquid, and at least two solid powders having different average particle diameters. The difference between the respective average particle diameters of the two different solid powders is at least 10  $\mu\text{m}$ . One of the solid powders is calcium carbonate. The other solid powder is an inorganic powder other than calcium carbonate such as glass powder, or it can be a polyethylene resin powder, an acrylic resin powder, or a silicone resin powder. Certain new and unexpected results are achieved by the composition, and are shown in appellants' specification in Table 1.

## ISSUES

There is one issue for consideration by The Board of Patent Appeals and Interferences. The issue is whether Claims 1-6 and 13 are patentable over Akamatsu (Japanese Publication 10-251517) under 35 USC Section 103(a).

## GROUPING OF CLAIMS

The pending claims stand or fall together as a group.

## ARGUMENT

The claims stand rejected under Section 103 (a) as being unpatentable over Akamatsu (Japanese Publication Number 10-251517).

Claims 1-6 and 13 are not anticipated by or unpatentable over Akamatsu because Akamatsu teaches using only one solid powder that is made of the same material, in two separate fractions, each fraction of the same material having different particle diameters. In contrast, appellants' invention as defined in Claim 1, is directed to using two different solid powders, each made of a different material one from the other, and in which each different solid powder has a particle diameter that is different from the particle diameter of the other solid powder.

These differences provide the new and unexpected results shown in Table 1 in appellants' specification. Thus, the three Application Examples 1-3 contained two different solid powders made of different materials, i.e., calcium carbonate and glass beads. The two Comparative Examples 1 and 2, on the other hand, contained the same solid powder, i.e., glass beads, in two different sizes. Comparative Example 2, it is noted, is generally representative of the type of

composition taught by Akamatsu, i.e., in which a single solid powder of the same material in two different sizes is employed.

As a consequence, and as can be seen in Table 1, the Vibration Damping Characteristics of each of appellants' Application Examples 1-3 changed less over a temperature range of -20 °C to 60 °C, as compared to the corresponding Vibration Damping Characteristics of Comparative Examples 1 and Comparative Example 2 (representative of Akamatsu) over the same range.

In addition, Akamatsu also fails to teach using the combination of (i) calcium carbonate as one of the solid powders, and (ii) another solid powder which is an inorganic powder other than calcium carbonate such as glass powder, or a polyethylene resin powder, an acrylic resin powder, or silicone resin powder.

In these regards, the attention of The Board of Patent Appeals and Interferences is respectfully directed to the fact that new and unexpected results are probative of novelty and unobvious. For example, in *In re Soni*, 54 F.3d 746, 34 USPQ2d 184, (Fed. Cir. 1995), the Federal Circuit stated:

"One way for a patent applicant to rebut a *prima facie* case of obviousness is to make a showing of "unexpected results," i.e., to show that the claimed invention exhibits some superior property or advantage that a person of ordinary skill in the relevant art would have found surprising or unexpected. The basic principle behind this rule is straightforward - that which would have been surprising to a person of ordinary skill in a particular art would not have been obvious".

The Examiner however has apparently overlooked these new and unexpected results, and the differences noted above, while at the same time acknowledging that:

"Akamatsu et al fail to teach a combination of calcium carbonate with a different powder having a different particle size. Furthermore, Akamatsu et fail to teach using calcium carbonate in

combination with glass powder"..... and that "the reference may not teach calcium carbonate specifically in combination with another powder".

#### CONCLUSION

For the foregoing reasons, the Honorable Board of Appeals is requested to reverse the Examiner's rejection of Claims 1-6 and 13.

#### HEARING

An oral hearing is not requested.

Respectfully submitted,

DOW CORNING CORPORATION

A handwritten signature in black ink, appearing to read "Jim L. De Cesare", is written over the printed name.

Jim L. De Cesare, Reg. No. 27,979, (989) 496-4235

## APPENDIX

Claim 1: A viscous liquid vibration damping composition comprising (A) 30-95 weight percent of a viscous liquid, and (B) 5-70 weight percent of at least two solid powders having different average particle diameters, the difference between the respective average particle diameters of the solid powders being at least 10  $\mu\text{m}$ , where one of the solid powders is calcium carbonate, and the other solid powder is an inorganic powder other than calcium carbonate, a polyethylene resin powder, an acrylic resin powder, or a silicone resin powder.

Claim 2: A viscous liquid vibration damping composition according to Claim 1 wherein (A) is mineral oil, vegetable oil, a synthetic oil, or a silicone oil.

Claim 3: A viscous liquid vibration damping composition according to Claim 2 wherein (A) is a silicone oil with a kinematic viscosity of 100-1,000,000  $\text{mm}^2/\text{s}$  at 25 °C.

Claim 4: A viscous liquid vibration damping composition according to Claim 1 wherein the difference between the respective average particle diameters of the solid powders is at least 15  $\mu\text{m}$ .

Claim 5: A viscous liquid vibration damping composition according to Claim 4 wherein the average particle diameters of the solid powders are 1-200  $\mu\text{m}$ .

Claim 6: A viscous liquid vibration damping composition according to Claim 5 wherein the average particle diameters of the solid powders are 10-150  $\mu\text{m}$ .

Claim 13: A viscous liquid vibration damping composition according to Claim 1 wherein the calcium carbonate powder has an average particle diameter of 10-30  $\mu\text{m}$ , and the other solid powder is a glass powder with an average particle diameter of 70-120  $\mu\text{m}$ .